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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,659	06/10/1999	DAVID A. FENTON	99-40113-US	8381

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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/329,659

Applicant(s)

FENTON ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In the amendment filed 8/13/03 in paper number 19, the following has occurred: Claims 1, 13, 14, 23 and 32 have been amended. Now claims 1-40 are presented for examination.

Specification

2. The amendment filed 8/13/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added recitation of automatically approving or denying the application based on a comparison of data contained in the application with "real-time current" underwriting criteria within claims 1, 13, 14, 23 and 32 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find, any support for a "real-time current" underwriting criteria feature within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office action.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. The specification is objected to under 35 U.S.C. § 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed for the reasons given in section 2 above.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase “real-time current underwriting criteria” is unsupported by the specification.

Independent claims 1, 13, 14, 23 and 32 recite limitations that are new matter.

Claims 2-12, 15-22, 24-31, and 33-40 incorporate the deficiencies of independent claims 1, 13, 14, 23 and 32, through dependency, and are also rejected.

(A) Claims 1, 13, 14, 23 and 32 have been amended to now recite the feature of automatically approving or denying the application based on a comparison of data contained in the application with “real-time current” underwriting criteria. However, it is unclear as to what a “real-time current” underwriting criteria actually is. Does Applicant seek patent protection for a system that issues and activates insurance policies in “real time” or for a system that approves and offers an insurance policy according to “real time” underwriting criteria?

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Applicant is respectfully requested to clarify the above issues, provided there is clear support for the “real-time current” feature in the specification as originally filed.

(B) Claims 2-12, 15-22, 24-31, and 33-40 incorporate the deficiencies of independent claims 1, 13, 14, 23 and 32, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in 8/13/03 amendment are NOT new matter, and are provided hereinbelow for Applicant’s consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 2-6 above in the next communication sent in response to the present Office Action.

8. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,831,526 to Luchs et al. and “Instant Auto Insurance Quotes Now available at Quotesmith.com” to Bland in view of U.S. Patent No. 5,845,256 to Pescitelli et al., for substantially the same reasons given in the previous Office Action (paper number 16) further in view of Lent et al. Further reasons appear below.

(A) As per claims 1, 13, 14, 23 and 32 has been amended to now recites “... real-time current underwriting criteria” and “... approved based on the real-time current underwriting criteria and ...”

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As per this limitation, Luchs et al., Bland and Pescitelli et al. teach a method of processing an insurance application involving receiving the application for a insurance from a user over a computer network (see: Luchs: column 3, lines 5-16) as well as issuing and activating the policy upon electronic acceptance and payment via an electronic payment occur during single user session (see: Pescitelli et al.: column 2, lines 54-58 and column 3, lines 1-28 and column 14, lines 32-49).

Luchs et al., Bland and Pescitelli et al. fail to teach offering a policy of insurance to the user based upon on real-time current underwriting criteria.

Lent et al. teaches a system and method for providing real time approval credit over a network involving an underwriter (110, Fig. 1) receiving data from the parsing engine and evaluating the data to determine if an applicant should receive an offer for credit by comparing the applicant's Fair Isaac Risk Score (FICO) to certain thresholds (see: column 4, lines 18-37 and abstract). The FICO Score is updated in real time and used for approval and offering of credit to applicant.

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the comparing of an applicant's FICO score to determine the approval and offering of credit to the applicant as taught by Lent et al. with the system taught by Luchs et al., Bland and Pescitelli et al. with the motivation of obtaining credit bureau information and making an underwriting decision in real time (see: Lent et al.: column 1, lines 55-59).

Response to Arguments

9. Applicant's arguments filed 8/13/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 8/13/03.

(A) In the remarks, Applicants argue in substance that, (1) Examiner fails to establish conditions for patentability; non-obvious subject matter and *prima facie* case of obviousness; (2) Luchs and Bland fail to teach issuing and immediate activating of an insurance policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and wherein the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period.

(B) In response to Applicant's argument that, (1) Examiner fails to establish conditions for patentability; non-obvious subject matter and *prima facie* case of obviousness. The Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837

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F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

(C) In response to Applicant's argument that, (2) Luchs and Bland fail to teach issuing and immediate activating of an insurance policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and wherein the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period. The Examiner respectfully submits that Pescitelli et al. teaches an interactive self-service vending system involving a interactive vending stations or terminals comprise data processing means, data storage means, input means, message output means, payment means and printer (see: column 2,

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lines 54-58). Pescitelli et al. further teaches that if a customer qualified for insurance and elects to purchase the policy a message directs the customer to pay using payment means such as a credit card (see: column 3, lines 1-5) and instructs the customer to sign his or her name on a signature pad (see: column 3, lines 27-28). Additionally, after the signature pad captures the customer's signature the insurance policy is issued at the kiosk begin the insurance coverage (see: column 14, lines 32-49). This clearly indicates that once the insurance policy is signed and issued to the customers at the kiosk, the insurance coverage starts immediately and all steps are performed during a single session at the kiosk.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM
rwm


JOSEPH THOMAS
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